

### **REMARKS**

Claim 1 has been amended, claim 3 has been cancelled without prejudice or disclaimer and claims 16-18 have been added. Claims 1, 2 and 4-18 are pending, and claims 5-7 and 9-15 have been withdrawn from consideration. Claims 1, 9, 12 and 16 are the independent claims. No new matter is presented in this Amendment.

Regarding newly added independent claim 16, it is noted that claim 16 recites, amongst other novel features, portions of each of the electrode tabs extending outside the case, and being bent only once in an upright position with respect to a plane of the sealing surface. As discussed below, none of the references cited, whether taken singly or combined, teach or suggest at least this novel feature of newly added claim 16, and therefore claim 16 is in condition for allowance. Furthermore, it is noted that claims 17 and 18 are also allowable at least because of their dependence from claim 16 and because they include novel features not taught or suggested by the prior art.

### **REJECTIONS UNDER 35 U.S.C. §102:**

Claims 1-3 and 8 are rejected under 35 U.S.C. §102(b) as being anticipated by Applicants' Admitted Prior Art (AAPA).

Regarding the rejection of independent claim 1, it is noted that claim 1 recites a pouch-type lithium secondary battery comprising: a battery unit comprising: a positive electrode plate, a separator, and a negative electrode plate, wherein the separator is disposed between the positive and negative electrode plates; electrode tabs extending from each of the positive and negative electrode plates of the battery unit, respectively; a case having a space to accommodate the battery unit; a sealing surface along the periphery of the space; and a protection circuit board electrically connected to the electrode tabs; wherein portions of each of the electrode tabs extend outside the case, and are bent at a substantially right angle with respect to a plane of the sealing surface.

The Office Action relies on AAPA for a teaching of the pouch-type lithium secondary battery and the electrode tabs extending outside the case and being bent at a substantially right angle with respect to a plane of the sealing surface. The Office Action further relies on FIG. 2 for a teaching of the tabs being bent in a substantially right angle. Applicants respectfully assert that AAPA does not teach these novel features.

AAPA discloses a lithium secondary battery having electrode tabs extending outside the case and being bent in an S-shaped form (FIG. 2), such that edges of the electrode tabs are bent once at portions where they extend outward from the sealing surface and are then bent again in the opposite direction (paragraph 0012). Accordingly, AAPA clearly discloses that the electrode tabs are bent in an S-shaped form, that is, the electrode tabs are bent almost a full 180 degrees in two different parts. Therefore, AAPA discloses electrode tabs bent at substantially 180 degrees and not electrode tabs bent at a substantially right angle with respect to a plane of the sealing surface, as recited in independent claim 1.

Accordingly, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. § 102(b) should be withdrawn because AAPA fails to teach or suggest each feature of independent claim 1.

As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Furthermore, Applicants respectfully assert that the rejection of dependent claims 2 and 8 under 35 U.S.C. §102(b) should be withdrawn at least because of their dependence from claim 1 and the reasons set forth above, and because the dependent claims include additional features which are not taught or suggested by the prior art. Therefore, it is respectfully submitted that claims 2 and 8 also distinguish over the prior art.

Regarding the rejection of dependent claim 3, it is noted that claim 3 has been cancelled without prejudice or disclaimer. Accordingly, the rejection of claim 3 is moot.

#### **REJECTIONS UNDER 35 U.S.C. §103:**

Claims 1-4 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of U.S. Pre-Grant Publication No. 2005/0112456 hereinafter Kozy.

Regarding the rejection of independent claim 1, it is noted that claim 1 recites a pouch-type lithium secondary battery comprising: a battery unit comprising: a positive electrode plate, a separator, and a negative electrode plate, wherein the separator is disposed between the positive and negative electrode plates; electrode tabs extending from each of the positive and negative electrode plates of the battery unit, respectively; a case having a space to accommodate the battery unit; a sealing surface along the periphery of the space; and a

protection circuit board electrically connected to the electrode tabs; wherein portions of each of the electrode tabs extend outside the case, and are bent at a substantially right angle with respect to a plane of the sealing surface.

The Office Action relies on Koizu for a teaching of the leads being bent at a substantially right angle and in particular relies on FIGS. 4C and 5A and paragraphs [0038] and [0039]. The Office Action further states that it would have been obvious to one having ordinary skill in the art to bend the tabs of AAPA at a substantially right angle such as taught by Koizu in order to make it easier to attach the protection circuit board to the tabs. Applicants respectfully assert that neither AAPA or Koizu, whether taken singly or combined, teach or suggest such features and furthermore, the motivation provided in the Office Action is nowhere found in the references.

Initially it is noted that although Koizu discloses bent electrode tabs attached to a circuit substrate 3 (FIG. 5A), the electrode tabs 4 and 5 do not extend outside the case. Rather the electrode tabs 4 and 5 are provided as separate elements from the case 2 (see FIG. 4C) and are soldered to the solder lands 32 and 33 (paragraph 0038) with a piece of insulating paper 34 interposed therebetween. Therefore, the electrode tabs do not extend outside the case but are rather located externally to the case.

Furthermore, it is noted that FIG. 5A of Koizu is an intermediate figure illustrating the assembly of the electrode tabs to the circuit substrate. It is actually FIG. 5B that illustrates the correct positioning of the electrode tabs with respect to the battery 2. As clearly illustrated in FIG. 5B, the electrode tabs are bent over so that the circuit substrate 2 is substantially parallel to the sealing plate 23 (paragraph 0039). Accordingly, the tabs are bent at an angle of approximately 180 degrees, and therefore are not bent at a substantially right angle as recited in independent claim 1.

Finally, the Office Action states that that it would have been obvious to one having ordinary skill in the art to bend the tabs of AAPA at a substantially right angle such as taught by Koizu in order to make it easier to attach the protection circuit board to the tabs. However, nowhere in Koizu is it taught or suggested that bending the tabs would make it easier to attach the protection circuit board to the tabs, as suggested in the Office Action.

It is noted that as a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be

shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03.

In the instant case, none of the references cited, provide the motivation alleged in the Office Action.

Accordingly, Applicants respectfully assert that the rejection of independent claim 1 under 35 U.S.C. §103(a) should be withdrawn because neither AAPA or Kozu, whether taken singly or combined, teach or suggest each feature of independent claim 1 and furthermore, there is no motivation to modify the teachings of the references, as suggested in the Office Action.

Furthermore, Applicants respectfully assert that dependent claims 2, 4 and 8 are allowable at least because of their dependence from claim 1, and because they include additional features which are not taught or suggested by the prior art. Therefore, it is respectfully submitted that claims 2, 4 and 8 also distinguish over the prior art.

Regarding the rejection of dependent claim 3, it is noted that claim 3 has been cancelled without prejudice or disclaimer. Accordingly, the rejection of claim 3 is moot.

#### **DOUBLE PATENTING:**

Claims 1, 4 and 8 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 and 3-6 of copending Application No. 11/256,131.

Since claims 1, 4 and 8 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claims would be premature (see MPEP 804).

Moreover, Application No. 11/256,131 is entitled "Facility for Highlighting Documents accessed through search or browsing," and does not appear to relate to the instant application. As such, it is believed that the Examiner intended to reference 11/265,131.

As such, it is respectfully requested that Applicants be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claims under 35 U.S.C. §§102 and 103 are resolved.

Claims 1-4 and 8 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/280,463.

Since claims 1, 4 and 8 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claims would be premature (see MPEP 804).

As such, it is respectfully requested that Applicants be allowed to address any provisional obviousness-type double patenting issues remaining once the rejections of the claims under 35 U.S.C. §§102 and 103 are resolved.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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